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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/520,545

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Samantha Champ

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7590

07/11/2008

MARSHALL, GERSTEIN & BORUN LLP

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EXAMINER

ZEMEL, IRINA SOPHIA

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

07/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/520,545

Applicant(s)

CHAMP ET AL.

Examiner

Irina S. Zemel

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

As a preliminary matter, the Examiner wishes to point out that she disagrees with the applicants interpretation of the claims as requiring the claimed polymers (as per base claims 1 and 11) to be hydrophilic. The examiner does not recall the substance of the interview in detail, thus, she does not deny that it is possible that the examiner agreed with the applicants interpretation of the claims during the telephonic interview. However, upon closer reading of the claims, the examiner disagrees with such interpretation as per explanation below.

While the recitation quoted by the applicants "water-absorbent open-celled crosslinked acid-functional addition polymer" arguably requires the polymers to be hydrophilic, the claimed limitations do not refer to the polymer, rather they refer to the claimed foam. Specifically, claim 1 (and respectively 11) reads: "An article formed from a water-absorbent open-celled crosslinked acid-functional addition polymer foam ..." (emphasis added). The recited limitation for water absorbency not only does not require anything (neither the polymer, nor the foam) to be hydrophilic, it is specifically refer to the foam, not the polymer. First of all, the claimed limitation "water absorbent" only requires the foam to be capable of absorbing water (in any amount), which, clearly does not require hydrophilic characteristic of the foam, as vast majority of open cell foams absorb at least some amount of water, even if the foam is highly hydrophobic (such as crosslinked household rubber sponges). Second of all, as noted, the "water absorbent" limitation is clearly a characteristic of the foam, an not the polymer. This interpretation of the claims is further supported in view of the fact that this limitation precedes the

limitation of the foam being "open cell". Clearly, the claimed polymer (or any polymer, for that matter) can not be "an open cell" polymer. The recited limitations ass refer to the characteristics of the foam, not the polymer.

Claim Rejections - 35 USC § 102/103

Claims 1-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 99/44648 to BASF AKTIENGESELLSCHAFT, hereinafter "BASF '648"). US corresponding document 6,455,600 is relied upon as an English translation of the Basf '648 document and the reference is made to the relevant potions of the US document) or by WO 00/52087 to BASF AKTIENGESELLSCHAFT, *hereinafter "BASF '087"). US corresponding document 6,750,262 is relied upon as an English translation of the Basf '648 document and the reference is made to the relevant potions of the US document).

The disclosure of both references is discussed in detail in the Office Action dated 6-5-2007, which entire office action is incorporated into the instant rejection by reference.

As discussed in 6-5-2007 Office action, both reference disclose articles formed form water absorbent open cell crosslinked polymer comprising acrylic acid. The articles contain surfactant, which makes this surfactant inherently present to at least some degree in the surface layer of the article. The references further expressly disclose that the amounts of surfactants can be as high as 20 %, which will inherently result in the article having relatively high amounts of surfactants on the surface (as well as throughout the entire foamed body. It is noted that the claimed products (even

though in the "product by process" format) do not define "surface" by any physical or geometric characteristics, such as thickness (either by its dimension or relative to the entire article). Thus, depending of what "surface" portion is considered as "surface" (such as, for example, 10% of the of the foam thickness) for surfactant amounts of 20 % based on the composition, the "surface" will inherently meet the claimed limitation as containing contain 10 % of the surfactant amount.

As discussed in the previous office action, the step of application of surfactant to the surface, does not distinguish the foam from the foams disclosed in the reference as no requirement of applying a surfactant in any amount is claimed in the claims, an it can be as low as a faction of a percentage point that will not distinguish the claimed product form the disclosed foams. The burden is shifted to the applicants to provide factual evidence to the contrary.

The claimed limitations of claims 17 and 18 are further considered to be inherently met by the disclosed articles in the embodiments where the surface of the article is lacking additional surfactant, but is treated with silicon dioxide (and crosslinked) as evident from the applicants disclosure. The burden is shifted to the applicants to provide factual evidence to the contrary.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,3,5,6,8, 9, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,071,580 to Bland et al., (hereinafter "Bland").

Bland discloses articles made from water absorbent open cell foams, said articles having their surface treated with a surfactant. See, for example, the abstract and the entire document. The reference further expressly discloses that the suitable polymers can contain cid functional co-monomers, such as acrylic acid. See, for example, the paragraph bridging columns 6 and 7. In addition, the reference expressly discloses that the foams can be either non-crosslinked or crosslinked. See column 9, lines 54-61. The reference further expressly discloses articles that are made from the disclosed foams, including baby diapers, etc. See column 11, lines 4-8. The reference discloses foamed sheets according to the invention of the thickness of about 3 mm cut out of the foam sheets (see illustrative examples). Bland further expressly discloses treating the open cell foams with surfactant to provide hydrophilic properties to the foams. In examples, the reference disclose dipping the foam in surfactant solution and drying the foam, so that the weight of the residue surfactant is about 4 % by weight of the foam. See example 2. The reference does not disclose the droplet acquisition time property of the resulting hydrophilic foams, however, in view of te fact that the foams are rendered hydrophilic by surface treatment with surfactant, it is reasonable believed that this property of the treated foams increases significantly as compared to the untreated foams, thus inherently meeting the limitation of claim 17. The burden is shifted to the applicants to provide factual evidence to the contrary.

Response to Arguments

Applicant's arguments with respect to all pending claims have been considered but are moot in view of the new ground(s) of rejection.

The explanation of rejection and claim interpretation is discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/
Primary Examiner, Art Unit 1796

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ISZ

